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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,817	06/23/2000	Brigido A. Borquez	3536P2177	7162
23504	7590	08/10/2004	EXAMINER EDOUARD, PATRICK NESTOR	
WEISS & MOY PC 4204 NORTH BROWN AVENUE SCOTTSDALE, AZ 85251			ART UNIT 2654	PAPER NUMBER

DATE MAILED: 08/10/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/599,817

Applicant(s)

BORQUEZ ET AL.

Examiner

Patrick N. Edouard

Art Unit

2654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 3/18/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Office Action is in response to communication filed 3/18/04 (paper #5).

Claims 1-7 are pending.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al (5,884,256)

As per claim 1, Bennett et al teach a method for simultaneously translating from a source language to a target language comprising the steps of

"providing a recording device capable of recording words spoken in a source language" (col. 25, lines 54-62, his tape recorder 351);

"wherein said recording device further comprises means for playing back said words in said source language" (his tape recorder 351 can play back previously recorded audio upon request);

"speaking said words in said source language" (the witness responds with answers to question ask by an examining attorney, col. 2, lines 59-62 col. 8, lines 45-50);

“recording said words in said source language in said recording device”( col. 25, lines 54-62, his tape recorder 351);

“playing back said words in said source language to a human translator” (suggested by his playing back the source language to a stenographer”.

It is noted that Bennett et al teach the claimed invention but does not explicitly teach said human translator simultaneously translating said word in source language into a target language during a legal proceeding as they are being played back. However, Bennett et al teach the system comprising a machine translation at col. 16, lines 37-45. Therefore, one having ordinary skill in the art at the time the invention was made would have it obvious to recognize that a human translator could be used for the purpose of translating languages because he would provide accurate translations where context would be taken into consideration.

As per claim 2 ,It is noted that Bennett et al teach a tape recorder but does not explicitly teach a digital recorder. However, this feature is well known in the art. Therefore, one having ordinary skill in the art would have it obvious to recognize that the tape recorder of Bennett could be replaced by a digital recorder because it would provide a system capable of retrieving information with ease.

As per claim 4, Bennett et al teach providing one earphone assembly coupled to said recording (his tape recorder 351).

As per claims 5 and 6, Bennett et al teach providing at least one microphone in a position that is remote from said recording device (figure 11, his microphone 451).

As per claim 7, it is noted that Bennett et al teach the claimed invention but does not explicitly teach providing means for adjusting the speed at which said words in source language are played back. However, this feature is well known in the art of recording. Therefore, one having ordinary skill in the art at the time the invention was made would have it obvious to recognize that the recorder could be adjusted to play at a slower or faster speed because it would be user friendly allowing them to play back the recording with variable speed.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al (5,884,256).

Bennett et al teach the claimed invention but does not explicitly teach providing a telephone input coupled to said recording ... and to transmit said words translated into said target language over telephone line. However, this feature is well known in the art as evidenced by Cherny who teaches at the abstract, the words spoken into a telephone are translated and produced as synthesized voice signals from another telephone. Therefore, one having ordinary skill in the art the time the invention was made would have found it obvious to recognize that the words spoken as taught by Bennett could be translated over a telephone because it would provide to users speaking different languages the ability the understand the conversation in their native language.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick N. Edouard whose telephone number is 7033086725. The examiner can normally be reached on T-F 7:30-6:00.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on 703 3059645. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patrick N. Edouard

July 9, 2004



**PATRICK N. EDOUARD**  
**PRIMARY EXAMINER**